REMARKS

Upon entry of this amendment, claims 1-7 and 11-12 will be pending. Claims 8-10 are withdrawn. Claim 11 has been amended to delete "by the process of claim 8", and adds no new matter. No claims have been added, or cancelled. Reconsideration is respectfully requested in view of the above amendment and following remarks.

1. Rejection of claims 11 and 12 under 35 U.S.C. §112, second paragraph.

In view of the amendment to claim 11, Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. §112, second paragraph.

2. Rejection of claims 1-7 under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 4,849,321 to Hung et al., hereafter "Hung".

The Examiner has rejected the instant claims as anticipated by Hung on the grounds that Hung's compound (III), hereafter "cmpd III" anticipates the instant claims, and further because cmpd III reads on claims 2-7. Applicants appreciate the detailed basis of rejection bust must respectfully disagree.

Applicants' claim 1 is directed to a compound which can be activated by actinic radiation, comprising at least one urethane group and having the formula I:

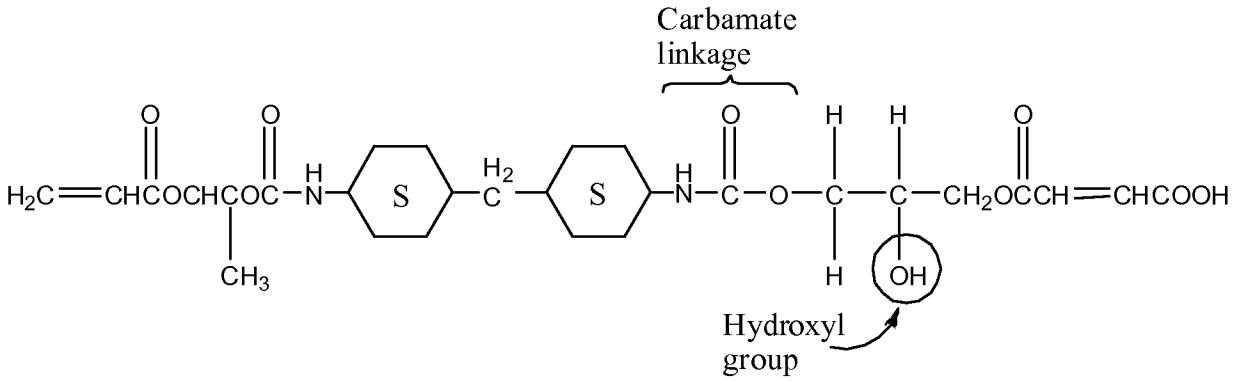
$$X[N(R)\text{-}C(O)\text{-}O\text{-}C(R^1R^2)\text{-}C(R^3R^4)\text{-}Y\text{-}Z]n \qquad (I)$$

wherein n is an integer from 1 to 5, X is an at least n-valent, substituted or unsubstituted organic radical, R is a hydrogen atom or a monovalent substituted or unsubstituted organic radical, R^1-R^4 independently of one another are a hydrogen atom, halogen atom or monovalent, substituted or unsubstituted organic radical, it being possible for at least two radicals to be cyclically linked to one another, Y is a divalent, linking functional group containing at least one oxygen atom, and Z is an organic radical containing at least one group which can be activated by actinic radiation, with the proviso that at least for n = 1 the radical R and/or the radical X are/is substituted by at least one substituent of the general formula II:

$$Z\text{-}Y\text{-} \qquad (II)$$

wherein Z and Y are as defined above.

Cmpd III disclosed by Hung has the following structure, reproduced below using ChemDraw for annotation purposes.



Applicants respectfully submit that Hung's cmpd III has a hydroxyl group as a substituent on the second carbon atom following the carbamate linkage as illustrated in the annotated cmpd III above.

In contrast, Applicants' formula I requires that the carbamate group, -N(R)-C(O)-O- in formula (I), two carbon atoms have substituents R^1, R^2, R^3, and R^4, $-C(R^1R^2)-C(R^3R^4)-$ in formula (I). R^1, R^2, R^3, and R^4 are independently a hydrogen atom, a halogen atom, or a monovalent, substituted or unsubstituted organic radical. The OH group disclosed by Hung does not constitute a hydrogen atom or a halogen atom, and it further does not constitute an organic radical, since organic radicals are generally known to be carbon containing aliphatic, cycloaliphatic or aromatic radicals. While an organic radical can further contain a hydroxyl group, a hydroxyl group by itself is not an organic radical.

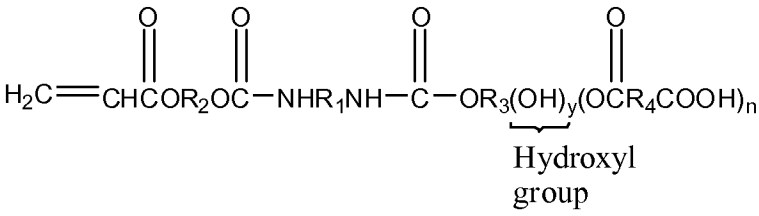
This is affirmed by Applicants' specification, where it is disclosed that suitable examples of organic radicals for Applicants' R^1, R^2, R^3, and R^4 are the monovalent substituted and unsubstituted organic radicals X. (Applicants' Specification as filed, page 11, lines 16-20). X is disclosed as alkyl, cycloalkyl, and/or aryl groups, especially alkyl and/or cycloalkyl groups. (Applicants' Specification as filed, page 8, lines 1-3). OH does not constitute an alkyl, cycloalkyl, or aryl group, and it is not a halogen or a hydrogen atom.

To anticipate a claim under 35 U.S.C. § 102, a single source must contain all of the elements of the claim. *Lewmar Marine Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1007 (1988).

This standard is not met by Hung. Applicants respectfully assert that for at least the reason discussed above, that is, for at least Hung's cmpd III having an OH group as a substituent on the second carbon following the carbamate linkage, the instant claims are not anticipated by Hung because Applicants' independent claim 1 requires that the second carbon following the carbamate linkage has as substituents a hydrogen atom, a halogen atom, or an organic radical. Hung's OH group fails to qualify as any of the these groups.

Accordingly, withdrawal of the instant rejection with regard to Hung's cmpd III is respectfully requested.

Moreover, Applicants further respectfully submit that cmpd III follows Hung's formula (III):



Hung's formula (III)

(Hung, column 5, lines 25-30).

Applicants respectfully assert that the instant claims are further not anticipated by Hung's formula (III) because as it can be seen, Hung's formula (III) also always contains at least one hydroxyl group on at least one of the two carbon atoms following the carbamate linkage.

This is due to the fact that Hung synthesizes the compounds of Hung's formula (III) using starting material of formula $R_3(OH)_x$, wherein R_3 is a C_3-C_6 alkylene, and x is 3-6. (Hung, column 5, lines 1-23). The only example given by Hung is glycerol, a C_3 polyol having three hydroxy groups, one on every carbon atom. Therefore, because Hung's polyols have a hydroxy group on every carbon atom, Hung's formula (III) does not anticipate the instant claims.

Further, Hung discloses that in the case where y = 0, then n is at least 2. This also does not anticipate Applicants' instant claims because in the case of Hung, having n as being at least 2 produces a compound having two terminal $OC(O)R_4COOH$ on the same side of the molecule. If construed in view of Applicants' formula (I), this would be the equivalent of two -Y-Z groups branching off of $-C(R^3R^4)-$, the latter being a carbon

linked to R^3, R^4, and to -C(R^1R^2)-, which renders the carbon atom effectively being 5-valent (R^3, R^4, -C(R^1R^2)-, and two -Y-Z groups). Of course, that is impossible.

Therefore, Applicants respectfully assert that not only does Hung's cmpd III not anticipate the instant claims, but also Hung's formula III does not anticipate the instant claims, at least in view of the above.

Withdrawal of the anticipation rejection with regard to Hung is respectfully requested.

CONCLUSION

Applicants respectfully submit that the Application and pending claims are patentable in view of the foregoing remarks. A Notice of Allowance is respectfully requested. As always, the Examiner is encouraged to contact the Undersigned by telephone if direct conversation would be helpful.

Respectfully Submitted,

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Monday, November 05, 2007
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